

**REMARKS/ARGUMENT**

Claim 1 has been amended by requiring the target to be capable of depositing film within a sputtering device, support for which exists throughout the entire specification.

Claims 1, 2 and 5-18, 20, 21 and 23-26 are currently pending.

The Office Action rejected (1) claims 1, 2, 23 and 24 under 35 U.S.C. § 102 as anticipated by U.S. patent 4,107,019 (“Takao”); (2) claims 1, 15, 23 and 24 under 35 U.S.C. § 103 as obvious over U.S. patent 4,961,979 (“Iida”) in view of U.S. patent 5,483,067 (“Fujii”); (3) claim 2 under 35 U.S.C. § 103 as obvious over Iida, Fujii and Takao; (4) claims 5, 6, 25 and 26 under 35 U.S.C. § 103 as obvious over Iida in view of Fujii and U.S. patent 5,981,092 (“Arai”); (5) claims 5, 6, 25 and 26 under 35 U.S.C. § 103 as obvious over Takao in view of Arai; (6) claims 7-14 under 35 U.S.C. § 103 as obvious over Iida in view of Fujii, Arai, and U.S. patent 5,522,976 (“Campet”); (7) claims 7-14 under 35 U.S.C. § 103 as obvious over Takao in view of Fujii, Arai, and Campet; (8) claims 16-18 under 35 U.S.C. § 103 as obvious over Iida in view of Fujii and U.S. patent 5,831,760 (“Hashimoto”); (9) claim 15 under 35 U.S.C. § 103 as obvious over Takao in view of Fujii; (10) claims 16-18 under 35 U.S.C. § 103 as obvious over Takao in view of Fujii and Hashimoto; (11) claim 20 under 35 U.S.C. § 103 as obvious over Iida in view of Fujii and IBM technical disclosure; (12) claim 20 under 35 U.S.C. § 103 as obvious over Takao in view of IBM technical disclosure; (13) claim 21 under 35 U.S.C. § 103 as obvious over Iida in view of Fujii U.S. patent 5,905,590 (“Van Der Sluis”); and (14) claim 21 under 35 U.S.C. § 103 as obvious over Takao in view

of Van Der Sluis. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

In making the above rejections, the Office Action asserted that the language “an essentially ceramic target for a sputtering device” in claim 1 is an intended use not given any patentable weight.

In response to this assertion, the body of the claims has been amended to require the target to be capable of depositing film within a sputtering device. This is not an intended use. Rather, this is a real limitation that must be satisfied. As indicated by the *Biacore v. Thermo Bioanalysis* case at p. 457 (copy attached), the comparable phrase “suitable for use” in the preamble informs the construction of the remainder of the claims by defining the apparatus -- the body of the claims are directed to an article that cannot be divorced from the intended field of use. It is only under the conditions imposed by the comparable phrase “suitable for use” that the elements of the claims perform the functions by which they are defined. Thus, the comparable phrase “suitable for use” breathes life into the present claims and, as such, is a real limitation which must be satisfied. This phrase is not merely a preambular intended use.

Here, the same logic applies. As set forth in the body of the claim, the claimed target must be capable of depositing film within a sputtering device. This phrase informs the construction of the rest of the claims by defining the apparatus (sputtering device), and the rest of the claims cannot be divorced from this phrase. It is only under conditions imposed by the phrase “capable of depositing film within a sputtering device” the claim elements perform the functions by which they are defined. Accordingly, the phrase does not merely set forth an intended use, but rather sets forth a real limitation which must be satisfied.

The two primary references, Iida and Takao, do not teach or suggest such a target: Takao relates to an oxygen sensor, while Iida relates to an optical recording medium. Nothing in either reference teaches or suggests the invention target structured such that it is suited for use in a sputtering device.

The secondary and tertiary applied references do not compensate for Iida’s and Takao’s fatal deficiencies. Nothing in any of the references would have motivated one of ordinary skill in the art to modify the oxygen sensor in Takao or the optical recording medium in Iida to yield an acceptable target in a sputtering device as required by the pending claims, and/or to modify them in such a way as to yield a target having the electrical resistivity set forth in the claims.

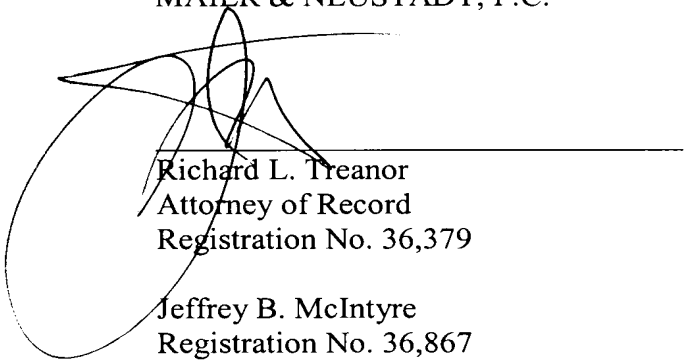
In view of the above, Applicants respectfully request reconsideration and withdrawal of the pending rejections under 35 U.S.C. §§ 102 and 103.

Application No. 10/502,052  
Response to Office Action dated February 3, 2009

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867

Customer Number

**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220